

REMARKS

With this Amendment, Applicants add new Claims 90 and 91 and amend claims 80 and 81. No new matter is added. Therefore, Claims 1-70 and 72-89 are all the claims currently pending in the present application.

Claims 2, 3, 6-32, 42-65, and 75-79 are withdrawn. Thus, Claims 1, 4, 5, 33-41, 66-74, and 80-91 are all the claims currently under consideration.

Formal Matters

Acknowledgement of IDSs. Applicants note that the Examiner has not considered and initialed the references submitted in the IDS filed on June 25, 2002. Therefore, Applicants respectfully request that a duly signed and initialed copy of the PTO-Form 1449, filed with the June 25, 2002 IDS, be returned with the next Office Action.

Applicants further request that a signed and initialed copy of the PTO-Form 1449, filed with an IDS on May 10, 2004, be returned with the next Office Action.

Claim Rejections. Claims 80, 88 and 89 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Iida, U.S. Patent No. 6,000,788 (“Iida”). Claim 88 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Iida, in view of Wu et al., U.S. Patent No. 5,851,004 (“Wu”). Applicants traverse these rejections as discussed below.

Claim Objections. Claims 81-87 stand objected to as dependent on a rejected base claim. However, the Examiner indicates that these claims would be allowed if rewritten into

independent form including all limitations of the base claims and any intervening claims from which they depend. With this Amendment, Applicants amend Claim 81 into independent form. Claims 82-87 depend from Claim 81. Therefore, Applicants submit that Claims 81-87 are currently in proper form for Allowance, and respectfully request that the objection to these claims be reconsidered and withdrawn.

Allowed Claims. In the current Office Action, the Examiner indicates that Claims 1, 4, 5, 33-41, 66, 69, 70, and 72-74 are allowed. Applicants note that Claim 33(1) is listed in the body of the Office Action as allowed, but that, in error, Claim 31(1) is listed on the Office Action cover sheet as allowed.

Claims 67 and 68. Applicants note that the Examiner has failed to discuss Claims 67 and 68, which depend from Claim 66, and which are not listed on either the Office Action cover sheet or within the body of the Office Action. Applicants submit that Claims 67 and 68 are patentable at least by virtue of their dependence on Claim 66, and respectfully request that Claims 67 and 68 be allowed.

Claim Rejections

Claims 80, 88 and 89 stand rejected under § 102(e) over Iida. Claim 88 also stands rejected under § 103(a) over Iida, in view of Wu et al.

To be an “anticipation” rejection under 35 U.S.C. § 102, the cited reference must disclose each and every element of Applicants’ claims. Rejections under § 102 are proper only when the

claimed subject matter is identically disclosed or described in the prior art. Moreover, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. (MPEP § 2143). As a result, in order for the Examiner to maintain a rejection under either §102 or §103, the cited references must teach all of the limitations of the claims.

Applicants respectfully submit that the references cited above by the Examiner fail to teach or suggest all of the claim limitations as set forth in the present invention.

Claim 88 over Iida. First, Applicants would like to point out that Claim 88 is rejected under both 35 U.S.C. § 102 and 103. Furthermore, the Examiner acknowledges that Iida alone fails to teach that the actuation body is a rod are recited in Claim 88. (Office Action, p.3) For this feature, the Examiner relies on the teaching of Wu. (Office Action, p.4) Since the Iida reference admittedly does not teach each and every limitation of Claim 88, Applicants submit that Iida cannot anticipate Claim 88 under §102(e). Therefore, Applicants submit that Claim 88 is improperly rejected under §102(e) and respectfully request that the rejection of Claim 88 §102(e) be reconsidered and withdrawn.

Claims 80, 88 and 89 over Iida. With respect to Claim 80, Applicants submit that Iida fails to teach or suggest that the exit port is not disposed within the diaphragm. As is clearly shown in Fig. 6B of Iida and as explained at col. 8, lines 40-59, ink from the ink chamber 4 flows through an alleged entrance port 23 found in valve assembly 9. The ink continues through the upper portion of the ink supply chamber 5 and out the alleged exit port 6 found in the diaphragm

3. However, Claim 80 recites that the exit port is not disposed within the diaphragm. Clearly, the alleged exit port 6 in Iida is found within the diaphragm 3. Therefore, Applicants submit that Iida fails to teach or suggest each and every limitation of Claim 80. Furthermore, Applicants submit that Claims 88 and 89 are patentable over Iida at least by virtue of their dependency from Claim 80.

In view of the above remarks, Applicants respectfully request that the rejection of Claims 80, 88 and 89 under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

Claim 88 over Iida and Wu. Regarding the rejection of Claim 88 under 35 U.S.C. § 103(a), Applicants submit that Wu fails to cure the deficient teachings of Iida. The Examiner alleges that it would have been obvious to combine the rod type actuation body to the valve unit of Iida. Assuming *arguendo* that such a modification was obvious, the modified valve unit would still fail to teach all of the limitations of Claim 88. Specifically, the modified valve unit would still have an exit port that would be located within the diaphragm. Therefore, since Wu fails to cure the deficient teachings of Iida with respect to the exit port and diaphragm, Applicants submit that the combined teachings of Iida and Wu fail to teach or suggest all of the limitations of Claim 88. Accordingly, Applicants request that the rejection of Claim 88 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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